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EXAMINER

AVELLINO, JOSEPH E

ART UNIT PAPER NUMBER

2143

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/558,924

Applicant(s)

KEMBEL ET AL

Examiner

Joseph E. Avellino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-29, 34-37, 41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-29, 34-37, 41 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/19/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 21-29, 34-37, 41-42 are presented for examination; claims 21 and 34 independent. The Office acknowledges the addition of claims 41 and 42.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 27-29 recite the limitation "said subsets" which lacks antecedent basis. Correction is required. For examination purposes, claim 21 will be interpreted as targeting an advertisement based on said determining, claim 22 will be interpreted as determining in real time, overlapping time periods, and claim 23 will be interpreted as determining what simultaneously displayed content is delivered to a single user.
5. Claim 29 is further rejected as not further limiting the parent claim. If both the first addressed content and the second addressed content were displayed simultaneously, on the same computing device, then it inherently must be sent to the single user. Correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-29, 34-37, 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel et al. (USPN 6,275,854) (hereinafter Himmel) in view of Merriman et al. (USPN 5,948,061) (hereinafter Merriman).

8. Referring to claim 21, Himmel discloses tracking distributed content within a computer network comprising:

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receiving a first information associated with a first addressed content displayed on a computing device, said first information comprising a first address corresponding to the first addressed content;

receiving second information associated with a second addressed content displayed on a computing device, said second information comprising a second address corresponding to the second addressed content, the first and second addresses are different (i.e. the advertisements A,B,C,D 606-612, all inherently have their own URLs as well as their own content) (Figure 6; col. 8, lines 15-20);

recording information (i.e. viewable intervals) that includes starting times and ending times for time periods (an inherent feature, otherwise it would be able to be determined when the advertisements were displayed on the computing device, since even a timer with a starting time of zero and an ending time of x still records a starting time of zero and an ending time of x) during which the first addressed content and the second addressed content were displayed on said computing device (done by the Javascripts associated with each advertisements (col. 8, line 42 to col. 9, line 15).

Himmel does not specifically disclose deriving whether the first and second advertisements were displayed during overlapping time periods. In analogous art, Merriman discloses another method of tracking distributed content within a computer network which discloses deriving, using recorded information, whether said first addressed content (i.e. the advertisement) and said second addressed content (i.e. the page) were displayed on said computing device during overlapping time periods (Figure 3B discloses an advertisement entry which discloses which webpages the

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advertisement has been viewed on "PAGES ADS SEEN ON" which inherently discloses that both the ad and the webpage were simultaneously displayed).

It would have been obvious to one of ordinary skill in the art to combine the teaching of Merriman with Himmel in order to utilize the viewable display information of Himmel to compile this information that can be used for targeting advertising as supported by Merriman (col. 2, lines 40-45).

9. Referring to claim 22, Himmel discloses the invention substantively as described in claim 21. Himmel further discloses recording additional information related to user activity during the time period during which said first addressed content was displayed on said computing device (col. 10, lines 10-17 "and any other additional information required"); and

correlating, using said recorded information the first addressed content that was displayed on said computing device with user activity on said computing device (an inherent feature, since this information was stored with the visible time and URL of the page and the cookie name which inherently includes the advertisements name since each advertisement has its own cookie) (col. 9, lines 10-15; col. 10, lines 10-20).

10. Referring to claim 23, it is inherent that the received information is associated with a set of data structures since data cannot be stored without some scheme as to how it is stored.

11. Referring to claim 24, Himmel discloses the invention substantively as described in claim 21. Himmel does not specifically disclose correlating a subset of data structures and using said subset to create a pack of data structures. In analogous art, Merriman discloses correlating a subset of data structures and using said subset to create a pack of data structures (i.e. pages ads seen on can be considered a pack of data structures) (Figure 3B). It would have been obvious to one of ordinary skill in the art to combine the teaching of Merriman with Himmel in order to utilize the viewable display information of Himmel to compile this information that can be used for targeting advertising as supported by Merriman (col. 2, lines 40-45).

12. Referring to claim 25, Himmel discloses the invention substantively as described in claim 21. Himmel discloses constructing a statistical database to track individual events executed at a plurality of computing devices that display said first addressed content (i.e. transmit information to the responsible server 188) (col. 10, lines 10-25) which inherently has a database incorporated into the server.

13. Referring to claim 26, it is inherent to the system of Himmel that there is a content database which characterizes (i.e. stores) the first addressed content displayed on said computing device, otherwise there would be no content from which to generate data.

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14. Referring to claim 27, Himmel discloses the invention substantively as described in claim 21. Although Himmel discloses the first and second addressed content are advertisements, the reference does not disclose utilizing these advertisements in order to targeting an advertisement to a user based upon the viewed information. In analogous art, Merriman discloses another method of tracking information which discloses targeting an advertisement to a user based upon viewed advertisements (col. 2, lines 37-45). It would have been obvious to one of ordinary skill in the art to combine the teaching of Merriman with Himmel in order to utilize the viewable display information of Himmel to compile this information that can be used for targeting advertising as supported by Merriman (col. 2, lines 40-45).

15. Claims 34-37 are rejected for similar reasons as stated above, furthermore the advertisements of Himmel can be displayed independently of each other since they are not dependent upon one another, they are dependent upon the JavaScript and the advertisement control module.

16. Referring to claims 41 and 42, they are rejected for similar reasons as stated above since the term "web page" can be broadly construed as "any entity which can be viewed in a browser window and has an independent identifier" as do the advertisements of Himmel.

Response to Amendment

17. The Office acknowledges the amendments to claims 21, 22, 25, 26, and 34, and the addition of claims 41-42.

18. Applicant's arguments with respect to claims 21-29, 34-37, and 41-42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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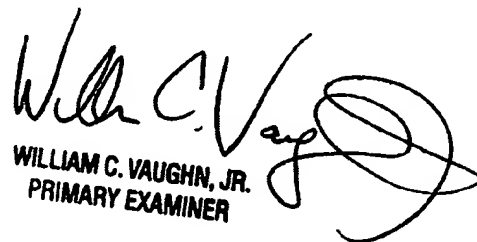
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEA
May 10, 2005



WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER